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09/927,163	08/09/2001	John Wilkes	10006371-1	4638

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

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ART UNIT	PAPER NUMBER
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN WILKES

Application No. 09/927,163
Technology Center 2100

Mailed: June 24, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.

PAMELA S. BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on June 22, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter requiring attention prior to docketing.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed March 17, 2009 under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 and 1207.03 (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds a new Ground of Rejection that has not been provided the required heading "New Grounds of Rejection" and/or which does not include the approval of the TC Director or his/her designee.

Specifically, the Examiner's Answer sets forth a rejection of claims 15, 22, 25, 30, 32 and 33 as being rejected under 35 U.S.C. § 102(e) as being anticipated by Pub. No. US 20010054131 A1 to Alvarez, II et al.; whereas the last Office action (Non-Final Rejection mailed July 10, 2008), including any mailed Advisory Action(s) finds that claims 15, 22, 25, 28, 30

and 32 and 33 are rejected under 35 U.S.C. § 102(e) as being anticipated by Pub. No. US 2001054131 A1 to Alvarez, II et al.

In addition, the Examiner's Answer sets forth a rejection of claims 1, 6-12, 16-19, 20-21, 23 and 28 as being rejected under 35 U.S.C. § 103(a) as being unpatentable over Pub. No. US 2001/0054131 A1 to Alvarez, II et al. in view of U.S. Patent No. 5,813,009 issued to Johnson et al.; whereas the last Office action (Non-Final Rejection mailed July 10, 2008), including any mailed Advisory Action(s) finds that claims 1, 6-12, 16-19, 20-21 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pub. No. US 2001/0054131 A1 to Alvarez, II et al. in view of U.S. Patent No. 5,813,009 issued to Johnson et al. Correction of all Grounds of rejection for all claims is required.

CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) to vacate the Examiner's Answer mailed March 17, 2009;
- 2) to generate a new Examiner's Answer setting forth the correct Grounds of rejection and to correct other sections of the Answer as may be required;
- 3) to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection);¹ and

¹ In Technology Center 2100, only a Director may approve new grounds of rejection.

4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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